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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/006,406 | 11/30/2001 | Bryan George Way | IDF 1239A (4000-04901) | 4112 |

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| EXAMINER | |
|---|---|
| SHAH, CHIRAG G | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2664 | |

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/006,406 | WAY ET AL. | |
| | Examiner | Art Unit | |
| | Chirag G. Shah | 2664 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11/30/01*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 21-33 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,343,079. Although the conflicting claims are not identical, they are not patentably distinct from each other because it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

The comparison of the Applicant's claims with U.S. Patent No. 6,343,079:

Regarding claim 1, Applicant's claim 1 merely broaden the scope of the patent number 6,343,079 with respect to claims 1 respectively by eliminating the terms: "wherein the network interface is operational to exchange the asynchronous transfer mode...connection"; "the

telephone interface is further operational to exchange analog telephone signals...connection"; "the computer interface is further operational to exchange the internet...connection"; "video interface...connection"; "the communications processing system...computer"; "the communication paths...interface"; "the substrate...video interface". It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding claims 21-33, Applicant's claims 21-33 merely broaden the scope of the patent number 6,343,079 with respect to claims 1-13 respectively by eliminating the terms: "wherein the network interface is operational to exchange the asynchronous transfer mode...connection"; "the telephone interface is further operational to exchange analog telephone signals...connection"; "the computer interface is further operational to exchange the internet...connection"; "video interface...connection"; "the communications processing system...computer"; "the communication paths...interface"; "the substrate...video interface". It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9, 11-12, 14-18, and 20 rejected under 35 U.S.C. 102(e) as being anticipated by Pfeffer (U.S. Patent No. 6,128,293).

Regarding claim 1, Pfeffer discloses in fig. 2 of an autonomous multi-services card **[the multiservice access unit 12, see fig. 2]** that comprises:

a computer interface **[Ethernet interface 46, fig 2]** that is configured for coupling to a host computer connection and that is operational to exchange data with the host computer connection;

a telephone interface **[telephone interface 42, fig. 2]** that is configured for coupling to a telephone connection and that is operational to exchange voice signals with the telephone connection;

a network interface **[high speed modem 56, fig. 2]** that is configured for coupling to a network connection and that is operational to exchange the data and the voice signals with the network connection;

a communications processing system **[microprocessor 52, fig. 2]** that is operational to control the exchange of the voice signals with the telephone connection and with the network

connection without any control input from the host computer connection, and to control the exchange of the data with the host computer connection and with the network connection;

communication paths **[buses interconnecting the interfaces and the processor, see fig. 2]** that connect the communications processing system with the computer interface, the telephone interface, and the network interface; and

a substrate **[not shown but inherently disclosed]** that is configured for physical attachment to a computer-compatible slot and that is connected to the computer interface, the telephone interface, the network interface, the communications processing system, and the communication paths. **Pfeffer further teaches that the network interface 56 is capable of accessing diverse communication networks, including, but not limited to, an ATM network, a PSTN (employing either ISDN, POTS, DSL etc.), Packet network (TCP/IP, X.25, Token ring etc.), and Frame Relay. The Pfeffer reference also describes the functions of all interfaces (42, 44, 46, and 48) and the processing system (52) as being claimed (see cols. 4 to 8).**

Regarding claim 2, wherein the network interface **[high speed modem 56, fig. 2]** is further operational to exchange asynchronous transfer mode communications **(see col. 3, lines 45-67 and col. 5, lines 38-51)** with the network connection and wherein the communications processing system is further operational to control the exchange of the asynchronous transfer mode communications with the network connection **[see col. 5, lines 15-50 and fig. 2]** as claim.

Regarding claim 3, wherein the network interface **[high speed modem 56, fig. 2]** is further operational to exchange Ethernet communications **(via Ethernet Interface 46, fig. 2)** with the network connection and wherein the communications processing system is further operational to control the exchange of the Ethernet communications with the network connection **[see col. 5, lines 15-50 and fig. 2]** as claim.

Regarding claim 4, wherein the network interface **[high speed modem 56, fig. 2]** is further operational to exchange digital subscriber line communications **(PSTN of fig. 1employing either ISDN, POTS, DSL etc., see col. 3, lines 45-58)**, with the network connection and wherein the communications processing system is further operational to control the exchange of the digital subscriber line communications with the network connection **[see col. 5, lines 15-50 and fig. 2]** as claim.

Regarding claim 5, wherein the network interface **[high speed modem 56, fig. 2]** is further operational to exchange Internet communications **(see col. 3, lines 14-30, full service provider server voice over data network)** with the network connection and wherein the communications processing system is further operational to control the exchange of the Internet communications with the network connection **[see col. 5, lines 15-50 and fig. 2]**.

Regarding claim 6, wherein the computer interface **[Ethernet interface 46, fig 2]**is further operational to exchange Internet communications **(see col. 3, lines 14-30, full service provider server voice over data network)** with the host computer connection and wherein the

communications processing system **[microprocessor 52, fig. 2]**is further operational to control the exchange Internet communications with the host computer connection **[see col. 5, lines 15-50 and fig. 2]**.

Regarding claim 7, wherein the telephone interface **[telephone interface 42, fig. 2]** is further operational to exchange analog telephone signals with the telephone connection and wherein the communications processing system **[microprocessor 52, fig. 2]** is further operational to control the exchange of the analog telephone signals with the telephone connection **[see col. 3, lines 55-67, fig. 2 and claim 2].**

Regarding claim 8, wherein the network interface **[high speed modem 56, fig. 2]** is further operational to exchange modem communications with the network connection and wherein the communications processing system **[microprocessor 52, fig. 2]** is further operational to control the exchange of the modem communications with the network connection **[see fig. 2 and respective portions of the specification].**

Regarding claim 9, wherein the modem communications are cable modem communications **[see col. 4, lines 63 to col. 5, lines 5 and claim 3, digital modems equate to cable modems]**.

Regarding claim 11, wherein the modem communications are telephone modem communications **[see col. 4, lines 63 to col. 5, lines 5 and claims 3 and 4, the high speed modem may be analog or ISDN digital modem for voice call communication]**.

Regarding claim 12, wherein the network interface is further operational to automatically sense the protocol used over the network connection **[see, col. 6, lines 37-58 and col. 8, lines 25-35, the PRA interface 60, frame relay interface, packet interface and ATM interface provide protocol conversion functionality enabling dynamic rate and protocol adaptation]**.

Regarding claim 15, further comprising a voice coder/decoder **[see col. 4, lines 63-col. 5, lines 5, PCM voice encoding and decoding]**.

Regarding claim 16, wherein the telephone interface **[telephone interface 42, fig. 2]** is operational to detect off-hook conditions, to detect on-hook connections, to detect tones, to provide dial tone, to provide ring current, to provide ringback tones, and to provide busy tones **[see, col. 7, lines 24-37, telephone interface 42 detects off-hook conditions, DTMF detection and ringing signal generation among other controlling functionality]**.

Regarding claim 17, wherein the communications processing system **[microprocessor 52 of fig. 2]** is operational to control the telephone interface to generate and receive telephone calls **[see col. 7, lines 24-44, the microcontroller 52 operates to control the telephone interface 42 to originate and receive calls]**.

Regarding claim 18, further comprising an enclosure that includes the slot **[see col. 2, lines 30-36, the service access unit is connectable to a plurality of terminal devices, the connection inherently uses a slot to connect to terminal devices].**

Regarding claim 20, wherein: the network interface **[high speed modem 56, fig. 2]** is operational to exchange asynchronous transfer mode communications and internet communications with the network connection and wherein the communications processing system **[microprocessor 52, fig. 2]** is further operational to control the exchange of the asynchronous transfer mode communications and internet communications with the network connection **[see col. 5, lines 15-50 and fig. 2]**;

the telephone interface **[telephone interface 42, fig. 2]** is further operational to exchange analog telephone signals with the telephone connection and wherein the communications processing system **[microprocessor 52, fig. 2]**is further operational to control the exchange of the analog telephone signals with the telephone connection **[see col. 3, lines 55-67, fig. 2 and claim 2]**; and

the computer interface **[Ethernet interface 46, fig 2]** is further operational to exchange the Internet communications with the host computer connection and wherein the communications processing system **[microprocessor 52, fig. 2]** is further operational to control the exchange of the Internet communications with the host computer connection **[see col. 5, lines 15-50 and fig. 2]**.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Pfeffer in view of Bender et al. (U.S. Pub No. 2003/0145119 A1), hereinafter Bender.

Regarding claim 10, Pfeffer in figure. 2 discloses of a high-speed modem 56 connected to terminal devices such as a Fax, PC, telephone etc. Pfeffer fails to explicitly disclose wherein the modem communications are wireless modem communications. Bender teaches of an interface between standard terminal equipment unit and high speed link. Bender discloses in fig. 3A of a wireless modem 42 connected to a terminal equipment unit for communication with other networks. Therefore, it would have been obvious to one of ordinary skills in the art to replace the high speed modem of Pfeffer's system with a wireless modem as taught by Bender in order to ensure mobility for accessing the network from a remote location.

7. Claim 13, 14 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Pfeffer in view of Riemann et al. (U.S. Pub No. 2005/0174990 A1), hereinafter Riemann.

Regarding claim 13, Pfeffer fails to disclose wherein the computer interface is further operational to receive power from the host computer connection. Riemann teaches of a client

NIC 30 in fig. 2 including a switching power supply 35. The switching power supply is operational based on fig. 3 to receive power form the host computer pc 18. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Pfeffer to include the teachings of the NIC receiving power from host pc as taught by Riemann in order to facilitate communication transmission within the LAN.

Regarding claim 14, Pfeffer fails to disclose wherein the computer interface is further comprises a battery terminal. Riemann teaches of a client network interface card (NIC) 30 in fig. 2 including a switching power/battery supply 35. The switching battery/power supply is operational based on fig. 3 to switching power. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Pfeffer to include the teachings of the NIC including a battery/power supply in order to facilitate communication transmission within the LAN.

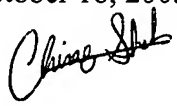
Regarding claim 19, Pfeffer fails to disclose wherein the computer interface is wherein the enclosure includes a battery terminal. Riemann teaches of a client NIC 30 in fig. 2 enclosure including a switching battery/power supply 35. The switching battery/power supply is operational based on fig. 3 to receive power. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Pfeffer to include the teachings of the NIC enclosure including a battery terminal as taught by Riemann in order to facilitate communication transmission within the LAN.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag G. Shah whose telephone number is 571-272-3144. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cgs
October 18, 2005



Chirag Shah
Patent Examiner, AU 2664